

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In application of: Parodi, Juan C.
 Serial No: 09/935,893
 Filed: 23 August 2001
 For: Endovascular Prosthesis with Suture Holder

Group Art Unit: 3731
 Examiner: Vy Q Bui

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT BEFORE MAILING DATE
 OF EITHER A FINAL ACTION OR NOTICE OF ALLOWANCE (37 CFR 1.97(c))**

NOTE: "An information disclosure statement shall be considered by the Office if filed ... before the mailing date of either (1) a final action under S 1.113 or (2) a notice of allowance under S 1.311, whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (e) of this section or the fee set forth in S 1.17(p)." 37 CFR 1.97(c).

NOTE: "If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "If information submitted during the period set forth in 37 CFR 1.97(c) with a certification is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. However, the information submitted with a certification can be used in a new ground of rejection and the next Office action made final, [i]f the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted, e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the fee set forth in 37 CFR 1.17(p), the Office action shall not be made final." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

WARNING: "A PETITION FOR SUSPENSION OF ACTION TO ALLOW APPLICANT TIME TO SUBMIT AN INFORMATION DISCLOSURE STATEMENT WILL BE DENIED AS FAILING TO PRESENT GOOD AND SUFFICIENT REASONS, SINCE 37 CFR 1.97 PROVIDES ADEQUATE RECOURSE FOR THE TIMELY SUBMISSION OF PRIOR ART FOR CONSIDERATION BY THE EXAMINER." NOTICE OF JULY 6, 1992 (1141 O.G. 63).

**TIME OF TRANSMITTAL OF ACCOMPANYING INFORMATION
 DISCLOSURE STATEMENT**

- The information disclosure statement transmitted herewith is being filed AFTER THREE MONTHS OF THE FILING DATE OF THIS NATIONAL APPLICATION OR THE DATE OF ENTRY OF THE NATIONAL STAGE AS SET FORTH IN S 1.491 IN AN INTERNATIONAL APPLICATION OR AFTER THE MAILING DATE OF THE FIRST OFFICE ACTION ON THE MERITS, WHICHEVER EVENT OCCURRED LAST BUT BEFORE THE MAILING DATE OF EITHER:

- (1) a final action under § 1.113 or
 - (2) a notice of allowance under § 1.311,
- whichever occurs first.

08/18/2004 HALI11 00000064 09935893

03 FC:1806 180.00 DP

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, with sufficient postage in an envelope addressed as follows: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on

13 August 2004

Signature of Person Signing

Judith Dunaway

Type or Print Name of Person Signing

CERTIFICATION OR FEE

2. Accompanying this transmittal is
(check either A or B below)
- A. ☐ a certification as specified in 37 CFR 1.97(e)
OR
- B. ☒ the fee set forth in 37 CFR 1.17(p) for submission of an information disclosure statement under S 1.97(c). (\$180.00).

FEE PAYMENT

(complete this item, if applicable)

3. Applicant elects the option to pay the fee set forth in 37 CFR 1.17(p) for submission of an information disclosure statement under S 1.97(c) (\$180.00).

Fee due \$ 180.00

METHOD OF PAYMENT OF FEE

4. ☒ Attached is check in the amount of \$ 180.00
- ☐ Charge Account No. in the amount of \$
A duplicate of this request is attached.

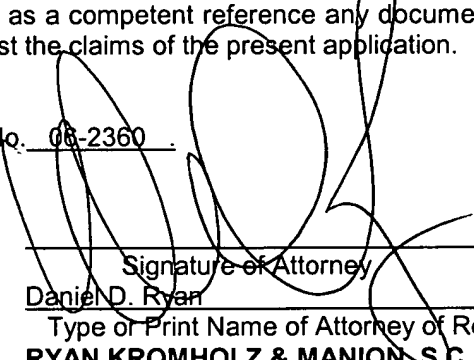
The submission of any document herewith is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* prior art reference against the claims of the present application.

If any additional fees are due, please charge Account No. 08-2360.

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Customer No. 26308



Signature of Attorney
Daniel D. Ryan

Type or Print Name of Attorney of Record
RYAN KROMHOLZ & MANION, S.C.
Post Office Box 26618
Milwaukee, Wisconsin 53226-0618

Mailing Address of Sender

LIST OF PRIOR ART CITED BY APPLICANT <small>(Use several sheets if necessary)</small> 	ATTY DOCKET NO. 9494.18128-CON 2	SERIAL NO. 09/935,893
	APPLICANT Juan Parodi	
	FILING DATE 23 August 2001	GROUP P. 1

U.S. PATENT DOCUMENTS

Examiner Initial	DOCUMENT NUMBER	Date	Name	Class	Subclass	Filing Date (If Appropriate)
	2,033,039	03 Mar 36	Limpert			
	3,686,740	29 Aug 72	Shiley			
	3,799,172	26 Mar 74	Szpur			
	4,140,126	20 Feb 79	Choudhury			
	4,307,722	29 Dec 81	Evans			
	4,580,568	08 Apr 86	Gianturco			
	4,781,682	01 Nov 88	Patel			
	4,898,577	06 Feb 90	Badger et al.			
	4,921,484	01 May 90	Hillstead			
	5,030,204	09 Jul 91	Badger et al.			
	5,042,707	27 Aug 91	Taheri			

FOREIGN PATENT DOCUMENTS

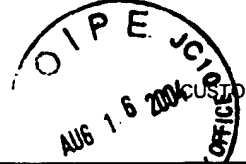
	DOCUMENT NUMBER	DATE	COUNTRY	Class	Subclass	Translation Yes No
	FR 2 299 548	1975	France			
	EP 0321912 A1	Dec 87	European			
	EP 0663184 A1	Jan 94	European			
	WO 97/03616	6 Feb 97	PCT			
	WO 99/53845	28 Oct 99	PCT			

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

		Advertising literature entitled "5mm Origin Tacker TM It Runs in Circles Around Staples" (origin) copyright 1995, with attached article entitled "The S piral Tacker: A New Technique for Stabilizing Prosthetic Mesh in Laparoscopic Hernia Repair" Nov 1995, Surgical Rounds
		MedPro Month October 1995, "Laparoscopic Surgery"
		Newman III, et al. Assisted TAPP Procedure " Circa 1995
		Hatchet, Lawrence, et al. "Extraperitoneal Endoscopic Burch Repair Using a Tacker Mesh Technique", Circa 1995.

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through and not considered. Include copy of this of with next communication to applicant.

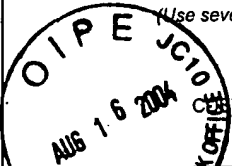
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	FILING DATE 23 August 2001	GROUP P. 2

U.S. PATENT DOCUMENTS

Examiner Initial	DOCUMENT NUMBER	Date	Name	Class	Subclass	Filing Date (if Appropriate)
	5,071,407	10 Dec 91	Termin et al.			
	5,104,399	14 Apr 92	Lazarus			
	5,330,503	19 Jul 94	Yoon			
	5,470,337	28 Nov 95	Moss			
	5,480,382	02 Jan 96	Hammerslag et al.			
	5,489,295	06 Feb 96	Piplani et al.			
	5,562,728	08 Oct 96	Lazarus et al.			
	5,571,171	05 Nov 96	Barone et al.			
	5,571,173	05 Nov 96	Parodi			
	5,582,616	10 Dec 96	Bolduc et al.			
	5,662,700	02 Sep 97	Lazarus			
	5,676,696	14 Oct 97	Marcade			
	5,676,697	14 Oct 97	McDonald			
	5,700,269	23 Dec 97	Pinchuk et al.			
	5,702,365	30 Dec 97	King			
	5,810,882	22 Sep 98	Bolduc et al.			
	5,824,008	20 Oct 98	Bolduc et al.			
	5,824,041	20 Oct 98	Lenker et al.			
	5,957,940	28 Sep 99	Tanner et al.			
	5,964,772	12 Oct 99	Bolduc et al.			
	5,972,023	26 Oct 99	Tanner et al.			

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	FILING DATE 23 August 2001	GROUP P. 3

U.S. PATENT DOCUMENTS

Examiner Initial	DOCUMENT NUMBER	Date	Name	Class	Subclass	Filing Date (If Appropriate)
	5,980,548	09 Nov 99	Evans et al.			
	5,993,401	30 Nov 99	Inbe et al.			
	6,126,685	03 Oct 00	Lenker et al.			
	6,145,509	14 Nov 00	Tanner			
	6,217,597	17 Apr 01	Tanner			
	6,248,118	19 Jun 01	Tanner et al.			
	6,258,119	10 Jul 01	Hussein et al.			
	6,270,516	07 Aug 01	Tanner et al.			
	6,287,315	11 Sep 01	Wijeratne et al.			
	6,296,656	02 Oct 01	Bolduc et al.			
	6,302,906	16 Oct 01	Goicoechea et al.			
	6,336,933	08 Jan 02	Parodi			
	6,371,919	16 Apr 02	Tanner et al.			
	6,409,757	25 Jun 02	Trout, III et al.			
	6,428,565	06 Aug 02	Wisselink			
	6,520,974	18 Feb 03	Tanner et al.			
	6,544,253	08 Apr 03	Tanner			
	6,562,051	13 May 03	Bolduc et al.			
	6,592,593	07 2003	Parodi et al.			
	5,855,565	01-1999	Bar-Cohen et al.			
	5,713,907	02-1998	Hogendijk et al.			
	5,993,466	11-1999	Yoon, Inbae			
	5,330,490	07-1994	Wilk et al.			
	5,968,053	10-1999	Revelas, Demetrios			
	6,592,593	15 Jul 03	Parodi et al.			

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